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Paper No. 15

HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re BJIP, Inc.

Serial No. 75/529,080

Kathleen M. Olster of Christie, Parker & Hale, LLP for
BJIP, Inc.

Lauriel Dalier, Trademark Examining Attorney, Law Office
113 (Meryl Hershkowitz, Managing Attorney).

Before Simms, Wendel and Bottorff, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

BJIP, Inc. has filed an application to register the
mark HAVANA for "furniture, namely, dining and occasional
indoor and outdoor furniture."¹

Registration has been finally refused on the ground
that the mark is primarily geographically deceptively
misdescriptive under Section 2(e)(3). Applicant and the

¹ Serial No. 75/529,080, filed July 30, 1998, claiming a first
use date and first use in commerce date of August 11, 1997.

Examining Attorney have filed briefs, but an oral hearing was not requested.

In order to establish a prima facie case that a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) the Examining Attorney must show that the mark (1) has as its primary significance a generally known geographic place, and (2) identifies products that purchasers are likely to believe mistakenly are connected with that location, i.e., would make a goods/place association. See *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539, 1540 (Fed. Cir. 1999); *Institut National des Appellations D'Origine v. Vinters International Co.*, 958 F.2d 1574, 22 USPQ2d 1190 (Fed. Cir. 1992). Needless to say, a preliminary requirement is that the goods with which the mark is being used do not originate from the named place.

Here the Examining Attorney maintains that the mark HAVANA is primarily geographically deceptively misdescriptive when used with applicant's furniture, which does not originate from Havana, Cuba. In support of her argument that the primary significance of the term Havana is as a generally known geographic location, the Examining Attorney has made of record a dictionary definition of

Havana as the capital and largest city of Cuba.² That applicant's goods do not originate in Havana is said to be evident not only from applicant's corporate location but also its statements concerning the U. S. trade sanctions against Cuba which would prohibit any such importation. To show that there is a "reasonable basis for concluding that there is a public association between applicant's furniture goods and the city of Havana," the Examining Attorney relies upon various excerpts from articles obtained from the Nexis database relating to the manufacture and sale of furniture in Havana. On the basis of this evidence, the Examining Attorney argues that a prima facie case has been made that applicant's mark is primarily geographically deceptively misdescriptive.

Applicant states that it does not dispute that the Examining Attorney has established that Havana is the name of a geographic location, that applicant's goods do not come from this location and that furniture is manufactured in Havana. (Reply brief, p.2). Applicant argues, however, that this is insufficient evidence to establish a prima facie case that purchasers would be likely to believe that applicant's goods originate from Havana. Applicant

² *The American Heritage Dictionary of the English Language*, 3rd ed. 1992.

contends that the requisite goods/place association between furniture and Havana in the mind of the public has not been established.

In support of its contention, applicant points to the Board's decision in *In re Municipal Capital Markets Corp.*, 51 USPQ2d 1369 (TTAB 1999) as being definitive of the type of evidence which the Examining Attorney must present to satisfy the goods/place association requirement. In that case the applicant was seeking to register the mark COOPERSTOWN for restaurant services. The Examining Attorney had compiled a large number of extracts from newspapers and magazines showing that there were restaurants in Cooperstown. The Board held that in order to prove a goods/place association, "the Examining Attorney must present evidence that does something more than merely establish that services as ubiquitous as restaurant services are offered in the pertinent geographic location." *Id.* At 1371. The Board held that the "mere fact that restaurant services were offered in Cooperstown ... is simply not sufficient by itself to establish the requisite goods/place association." Evidence such as that showing that the location had a somewhat greater than normal number of restaurants offering a particular cuisine was suggested as a possible satisfaction of the requirement.

Applicant argues that here also the Examining Attorney is required to show something more than the mere fact that goods as ubiquitous as furniture are offered or manufactured in Havana. Applicant argues that furniture is used in every household; everyone must furnish their homes or offices; and thus every community must have a place for purchasing furniture. Based on this reasoning, applicant insists that furniture must also be considered as a ubiquitous product and that, as a result, insufficient evidence has been made of record to establish a goods/place association.

We do not find the "something more" requirement of the *Municipal Capital* case applicable here. Although furniture is found in every home or office, it does not follow that furniture is offered or manufactured in every town. While it is hard to imagine even a small town without a restaurant of some type, furniture stores are not so commonly found. Although furniture may be used in every home or office, this can not be equated with the furniture being purchased in the same locality. Clearly, the public would not be likely to view each and every city or town as a place in which furniture is produced. No parallel can be drawn between the sale and production of furniture and the offering and provision of restaurant services. Thus, we

will not hold the Examining Attorney to the stricter standard of "something more" in establishing a goods/place association when furniture products constitute the goods in issue. We find the evidence of record adequate to establish prima facie that applicant's mark is primarily geographically deceptively misdescriptive.³

Applicant further argues that even if a prima facie case has been established, applicant has rebutted this prima facie case by showing that the term "Havana" is not being used to indicate a location, but rather to evoke a "life-style" or suggest a "desirable aura" of applicant's furniture. As support for its position, applicant points to excerpted Nexis articles which the Examining Attorney has made of record, although for a different purpose. In her response to applicant's request for reconsideration the Examining Attorney introduced these articles to buttress her arguments that Havana is associated not only with furniture but a style of furniture and that, as a

³ Applicant's argument that there is a further requirement that customers will not be deceived by applicant's mark because they will not rely upon the geographic significance of the mark in deciding to buy the product is not well taken. The refusal here is under Section 2(e)(3), not 2(a). The additional requirement that the geographic misrepresentation must be material to the decision of the purchaser to buy the goods bearing the mark comes into play only in a refusal that the mark is geographically deceptive under Section 2(a). See *Institut National v. Vintners International*, *supra*; *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992).

consequence, purchasers would be likely to believe that applicant's furniture was in fact from Havana. In a leading article we note excerpts such as the following:

... "Cuba is also well known for its colorful style and rich cultural heritage. So it's no surprise that the country has been a source of inspiration for designers and furniture manufacturers.

"In fact, I think consumers will begin to see more Cuba-inspired products, especially in home furnishings."

This trend we'll call "Old Havana Style" is taking over the country in everything from furniture to fabric to artwork.

Much of the furniture resembles European colonial or plantation-style with caning, carving and dark wood accented with decorative wrought iron. ...

... This design trend, experts agree, most likely started to emerge at the October 1998 International Home Furnishings Market with the introduction of Pennsylvania House's "Old Havana" and the "Havana" segment of Thomasville's "Ernest Hemingway" collection of furniture.

... Quintana, who is an assistant professor at Florida International University's School of Architecture in Miami, said the furniture created in Cuba was very beautiful, very useful and worth copying.

San Diego Union-Tribune (November 12, 2000)

Similar articles by the same author as published in three other newspapers were also made of record. In one of these we note the following additional discussion:

Nationally, "Havana" has become the new design buzzword. Pennsylvania House and Thomasville stamped the moniker on recent furniture lines. Scalamandre and Mulberry Home have introduced fabrics. Even

Pottery Barn featured a woven Havana trunk in its Early Fall 2000 catalog.

The Oregonian (October 14, 2000).

We agree that this evidence demonstrates that Cuba- or Havana-style furniture has become very popular in recent years in the United States. The name "Havana" or "Old Havana" has been adopted by other furniture houses in connection with certain lines of furniture, although whether it is being used as a brand name or a descriptive term is unknown. Nonetheless, we are not convinced that the evidence before us establishes other than that for which the Examining Attorney made it of record, namely that there is a distinctive type of furniture which originates in Havana and to which purchasers would be attracted for this very reason. Whether or not such a style has been copied by furniture manufacturers in the United States does not does contradict the primary significance of the term, as a geographic indication of the source of the style. We liken the situation here to that in *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031, 1034 (TTAB 1998) wherein the applicant argued that the term HAVANA, when used with rum and cocktails containing rum, evoked "an historical and stylistic image" associated with a "pre-Castro free-wheeling lifestyle." The Board held that "even if

applicant had established an association between HAVANA and a particular lifestyle, such association would not contradict the primary geographic significance of the term, as the association may be made precisely because of the primary significance of HAVANA as a city in Cuba."

Here we find the same to hold true. The primary significance of the term HAVANA is as a geographic location. The fact that a certain style of furniture is associated with this location does not detract from this primary significance but rather adds to the likelihood that purchasers would associate these goods with this location. Applicant has clearly failed to demonstrate that a domestic Havana-type of furniture has become so prevalent in the United States that purchasers would reasonably be expected to recognize that furniture of this nature was not actually produced in Havana, but rather was simply copies or U. S. renditions of a Havana-like style of furniture. See *In re Narada Productions Inc.*, 57 USPQ2d 1801 (TTAB 2001) (no evidence that there is a recognized genre or style of music known as "Cuba L.A." such that designation would be seen primarily as identifying such a style of music rather than the geographic origin of applicant's goods and services).

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The goods/place association remains strong between Havana and furniture. Accordingly, applicant has failed to rebut the prima facie case established by the Examining Attorney.

Decision: The refusal to register under Section 2(e)(3) is affirmed.

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